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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,603	02/19/2004	Robert E. Grove	2502187-991200	1625

EXAMINER	
SHAY, DAVID M	

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3735	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/783,603

Applicant(s)

GROVE ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 18, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-88,90-99 and 101-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-88,90-99 and 101-114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 18, 2008 has been entered.

Applicant argues that the claims are allowable over the teachings of Slatkine ('633) and has submitted two Declarations (the Declaration of John F. Black, hereinafter the "Black Declaration" and the Declaration of Gary C. Bjorklund, hereinafter the "Second Bjorklund Declaration") to bolster this assertion.

The examiner will now analyze the Second Bjorklund Declaration. The Second Bjorklund Declaration establishes the credentials of Declarant in the first paragraph. The second paragraph avers that Declarant has no relationship, nor financial interest in the outcome of this matter, nor the assignee. In paragraph 3, Declarant discusses the examiner's review of the previous Bjorklund Declaration, including the examiner's assertion on page 3 of the previous office action that the devices shown in Figures 14A and 14B appear to demonstrate eye safe arrangements. Declarant then notes that Figures 14A and 14 B and the text associated therewith were reviewed during the preparation of the previous Bjorklund Declaration and again during the preparation of the second Bjorklund Declaration. Declarant then states that the examiner "misapprehends" the teachings of Slatkine ('633) with respect to Figure 14A, noting that the exemplary wavelength with respect to this figure is 1.4 to 13 microns. Declarant then notes that these wavelengths are highly absorbed by water, and thus ineffective for hair removal, as they do not penetrate to the level of the hair follicle. The examiner cannot dispute this statement and

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thus it is convincing, with regard to the teachings relating to Figure 14A. There still remains the problem of Figure 14B, however. The discussion of Figure 14B is separate and apart from that of Figure 14A and its attendant wavelengths. Further, it is clear to the examiner, that the diffuser of Figure 14B will destroy the coherence of any incoming beam. The examiner notes that in the interviews conducted in April, that, if the examiner understands applicant's position correctly, the problem with many of the Slatkine ('633) diffusers is that they were designed to render incoherent light of the discussed intensity to be eye safe. And, if the examiner's understanding is correct, the use of the designs of Slatkine ('633) with laser light will, for the most part conserve the coherence thereof and thus still produce beams which are capable of causing severe damage to the eye. However, it is clear that Figure 14B, which is not limited to the wavelengths discussed with respect to Figure 14A, will produce an output wherein the path lengths of the various rays traced from the source beam will follow paths with different total lengths, and will thus destroy the coherence of the beam. This apart from the provision of an etched surface at the output face, as discussed at the first full paragraph on page 40 of Slatkine ('633), which would further serve to scatter the beam.

Paragraph 5 of the Declaration continues to discuss the embodiment of Figure 14A. As the examiner has already acknowledged the deficiency of this particular embodiment, it is not necessary to comment further on this paragraph.

In paragraph 6, Declarant states that the examiner's analysis of the previous Bjorklund Declaration with respect to the embodiment shown in Figure 8B of Slatkine ('633), "reflects the Examiner's misunderstanding of the principles of optical physics involved here" the examiner will accede to Declarant's expertise on this point. However, on review of the previous Bjorklund

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Declaration, there appears to be no configuration as described in Figure 8B of Slatkine ('633) in the table accompanying the previous Bjorklund Declaration, thus it has not been clearly demonstrated that this three element configuration will not work.

Therefore, at least with respect to the embodiments as illustrated in Figures 14B and 8B, the Declaration is not convincing.

Applicant has also submitted a Declaration by John F. Black (hereinafter, the "Black Declaration"), which the examiner will now analyze. In paragraph 1 Declarant sets forth his experience in the field establishing himself as one of skill in the art. In paragraph 2, Declarant notes that he has no financial interest in the outcome of this matter, although Declarant had at least a passing acquaintance with two of the instant inventor, when all were employed at Lumenis. In paragraph 3, Declarant discusses having reviewed the disclosure of Slatkine ('633) and has determined that Slatkine ('633) "fails to teach even one instance of a device which is eye safe and effective for hair removal". In paragraph 4, Declarant expressed surprise at the development of a device that could produce enough fluence for hair removal, yet be eye safe, noting "it was not obvious to me how such a combination was achieved".

While the examiner understands that Declarant does not believe that Slatkine ('633) teaches a diffusing setup that would provide the needed fluence at eye safe levels, there is no indication of how this conclusion was arrived at. It would appear that if Declarant had been given the instant disclosure, the same conclusion (that it was inoperative) could have been reached, especially in view of the statement in paragraph 4. Thus this Declaration is not convincing, containing mainly opinion.

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There also still remains the fact that nowhere in the originally filed disclosure is there any discussion of exactly how the claimed diffuser is made, it is merely stated that it can be made from various commercially available stock materials such as opalized glass, and tetrapolyflouroethylene (PTFE). Thus it is unclear, if the disclosure of Slatkine ('633) is not enabling, how the instant disclosure would be considered otherwise.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 80 and 96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 80, it is unclear what further limitation is intended to be implied by reciting the duration of the resultant hair removal. Claim 96 is indefinite because it is unclear how the device can be configured so that "the diffuser is larger in area than the input" when claim 94, from which claim 96 depends, requires that the light be distributed "uniformly across the input of the diffuser". This claim is too indefinite to apply art to.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 79-85, 88, 90-95, 97, 98, 101-103, and 105-114 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Slatkine (WO '633).

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See generally the entire document, and especially Figures 4a-d, 5d, 6a, 6bg, 7a-c, 8a, 8b, 9a, 9b, 10a, 10b, 1112a, 12b, 13, 14a, 14b, 15e, 15f, 16, 17a and pages 4, 9-11, 14-16, 22-32, and 41-44.

Claims 86, 89, 99, and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slatkine (WO '633) in combination with Grove et al ('901). Slatkine (WO '633) teach a device such as claimed, as set forth above, but does not disclose the device as including a diode bar per se. Grove et al ('901) teach the desirability of using diode bars in a dermatological device. It would have been obvious to the artisan of ordinary skill to employ the diode bars of Grove et al ('901) in the device of Slatkine (WO '633) since this provides high intensity light, thus producing device such as claimed.

Applicant's arguments filed March 18, 2008 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/
Primary Examiner, Art Unit 3735